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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,085	03/10/2000	Douglas S. Foote	9137.00	5683
26889	7590	07/31/2007		
MICHAEL CHAN NCR CORPORATION 1700 SOUTH PATTERSON BLVD DAYTON, OH 45479-0001				
			EXAMINER POINVIL, FRANTZY	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 07/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/522,085	Applicant(s) FOOTE ET AL.	
	Examiner Frantzy Poinvil	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 22, 23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 22, 23 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to the Arguments:

1. Applicant's representative argues that the PDA of Suer is not a cell phone, and that PDAs with cell phone functions did not exist prior to the applicant's invention.

In response, Suer clearly teaches that their PDAs include wireless means for transmitting/receiving data to/from an ATM device. See column 4, lines 29-59. Suer specifically states:

"In another aspect of the invention, the device may comprise a transceiver, e.g., such as an infrared (IR) transceiver, for wireless communication between the device and a terminal unit, such as a personal computer, an ATM, or a terminal at a merchant's site. An IR adapter may be plugged into the terminal unit's serial, parallel, Universal Serial Bus (USB), or IrDA port to receive data from the device. The device can thus, for example, transfer information about a financial transaction to accounting programs running on the PC. Because the IR adapter is part of the device, a separate cable does not have to be attached to and removed from the device. This allows the user to more quickly and easily communicate with the terminal unit.

The device may also allow point-of-sale transactions in which the device can be used to transmit user account data to the point-of-sale terminal to automatically transfer money from the user's banking account or other financial account to a merchant's account. The same device can use its IR connection to implement a point-of-sale transaction so that money is automatically debited from a checking or credit account. The user can thus purchase products from merchants without having to exchange paper, and the user and the merchant can both retain a complete digital record of the transaction. Additionally, because checking transactions may be fed into already existing check truncation software, it is possible for the transaction to be transmitted electronically from the user's account directly to the merchant's financial system. Thus, check truncation has the potential of dramatically reducing the handling costs of the merchant and the banks associated with a checking transaction. "

From this teaching, it is clearly seen that the PDA of Suer functions as a cellular phone or include means of a cellular phone such as an IR or transmitter/receiver for transmitting/receiving data to/from an ATM device as for performing banking related functions. Thus, applicant's argument that the ATMs of Suer do not dispense cash in response to commands received from a cellular phone is not convincing.

Applicant's representative then states that the PDA of Suer is not a TREO which is not qualified as prior art.

In response, a TREO is not being claimed or applied in the rejection. Therefore, the applicant's argument is persuasive. Moreover, the PDA of Suer includes all the means of a cellular phone for communicating with an ATM or other Point of sales devices.

Applicant's representative then argues that if a cellular phone is introduced in the system of Suer, the claimed invention will be unattainable.

In response, the PDAs of Suer includes an IR and wireless means for communicating with an ATM or point of sale device. Introducing a cellular phone in the PDA of Suer would have been obvious to one of ordinary skill in the art at the time the invention was made since all the components are already present in the PDA of Suer.

Applicant's representative then argues that the Examiner stated that it would have been obvious to one of ordinary skill in the art to add a cell phone in the system of Suer without any rationale for so doing.

In response, the PDA of Suer communicates with an ATM with similar wireless means of a cellular phone. It is noted that the main components of a cell phone include an IR or wireless transmitter/receiver for communicating with an ATM already exist in the PDA of Suer. Introducing a cellular phone therein would have been obvious to one of ordinary skill in the art to do at the time of the invention in order to provide telephonic options to the user of the PDA.

Applicant's representative then argues that the PTO's motivation using wireless commands from a portable device to an ATM is the same as applicant's motivation and concludes that such is improper.

In response, most PDAs are used by users to privately do so at their privacy or convenience. The motivation the Examiner has applied, flows naturally in the normal uses of a wireless phone or PDA as such the Examiner did not glance at the applicant's specification to provide such a motivation.

Applicant's representative then states that the mere fact that cell phones and PDAs share a common feature is not a reason for concluding that it is obvious to replace a PDA by a cell phone.

In response, PDAs and cell phone have and share common characteristics and also uncommon characteristics. In relation to the claimed invention, the PDA of Suer and a cell phone would serve the same purpose, which is communicating with an ATM. Introducing features of a cellular phone in the PDA of Suer has been discussed above..

Applicant's representative then argues that the Examiner's statement of the modified ATMs "still...perform in the same manner before and after modification" is incorrect and self-contradictory.

In response, applicant's comment is not persuasive. It is noted that only an additional feature of a cellular phone is added to the PDA of Suer. The ATMs whether modified or not with the addition of a transceiver to receive data from a cell phone would not operate in a manner different before modification as the operation of the ATMs

remain the same which is to perform banking functions. The only modification is the addition of a cell phone to the PDA.

Applicant's representative then argues that the Office action is not evaluating the invention as a whole and does not consider the recitation of the functioning ATM being in a public place is retrofitted with a cell phone.

In response, the Examiner disagrees. Most ATMs are usually placed in public places having high customer traffic. The ATMs in the system of Suer are retrofitted to include an IR and transmitter/receiver to communicate with the PDA.

The Prior Rejection is repeated below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 22-23 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suer et al. (US Patent No. 6,431,439) considered with Norris (US Patent No. 5,940,811) or Gustin et al (US Patent No. 6,012,048).

As per claims 1-3, 8, 22-23 and 25-29 Suer et al disclose a system and method for enabling the electronic capture and storage of financial transactions. See the abstract. In so doing, Suer et al substantially teach the claimed invention. Suer et al disclose a user having an

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electronic portable device such as a personal digital assistant (PDA) for running various types of financial software(s) for conducting financial transactions with an ATM, point of sales (POS) and other merchant computers. See column 3, line 54 to column 4, line 9 of Suer et al. Suer et al state that “the device may comprise a transceiver, e.g., such as an infrared (IR) transceiver, for wireless communication between the device and a terminal unit, such as a personal computer, an ATM, or a terminal at a merchant's site. An IR adapter may be plugged into the terminal unit's serial, parallel, Universal Serial Bus (USB), or IrDA port to receive data from the device.” See column 4, lines 29-37 of Suer et al. Suer et al further state on column 6, lines 49-55 that “the user may enter ATM transaction information, such as a personal identification number (PIN) and a transaction amount, into the device 10 and transmit the information from the device 10 to the ATM 20 so that the user may perform ATM functions (e.g., withdraw money, transfer money between accounts, and deposit money) using the device 10”. From these descriptions, it is clearly seen that Suer et al disclose a method comprising an ATM which has a screen for displaying options for withdrawing cash and a touch input mechanism for receiving user commands, and modifying the ATM to enable it to receive from a wireless device user commands for dispensing cash. Most ATM's are connected within a network. Suer et al do not explicitly state the portable device is a wireless telephone. The Examiner asserts that the device of Suer et al is a wireless device and that wireless devices include PDA's and cell phones and wireless phones. It would have been obvious to one of ordinary skill in the art at the time the invention was made to also include a wireless telephone device in the system of Suer et al in order to attract many types of users or customers having different types of portable devices. Furthermore, it is noted that the type of wireless devices being used therein would not affect the

system of Suer et al since such is merely used for the purpose of facilitating wireless communication with another terminal.

Applicant's representative has amended their independent claims to recite wherein

- “ 1) the ATM, prior to modification, is operative to (A) respond to user commands, including a command to dispense cash, and (B) cause a modification to the user's account,
- 2) the ATM, before and after modification, is connected to a host computer via a network,
- 3) before the modification, other ATMs are connected to the host computer via the network,
- 4) the other ATMs are operative to respond to user commands, including a command to dispense cash,
- 5) all said ATMs are located in public places, and
- 6) at least some of the other ATMs are not modified to enable them to receive from a wireless telephone user commands dispensing cash. “

In response, it is noted that the applicant's claims are reciting inherent or obvious uses of an ATM and places or locations that ATMs are usually found. Furthermore, ATM's are usually connected within a network to a remote computer. The purpose of an ATM is to facilitate uses of banking functions that are commonly performed between a teller and a customer in a bank. An ATM facilitates these functions into an interactive

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function between a user and a automatic teller machine wherein the machine is usually placed in a public location. Furthermore, the language found in the present claims are within a "wherein clause" and is a recitation that is neither "steps or functions or structures" to be performed any functions. The claim as amended appears to recite intended use or descriptive language or arguments so as to overcome the art of record. Furthermore, whether or not Suer et al recite that their ATMs before or after modification are or are not connected to a network or before or after modification, they are not being placed in a public place or before or after modification they do or do not respond to user commands, including a command to dispense cash and cause a modification to a user's account, the Examiner asserts that these are the usual functions of ATMs. ATM's usually respond to user commands, dispense cash, cause a modification to a user's account and are usually connected to a network. If any of the ATM's is subsequently modified to receive commands from a wireless telephone, then these ATM's would still continue to perform in the same manner before and after modification.

Applicant is referred to Norris or Gustin et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the ATM's of Suer et al in a network environment and in public locations in order to facilitate uses of the ATM's by remote customers not desiring to go to a bank in front of a human teller as in the system of Norris or Gustin et al.

As per claim 4, Suer et al teach the transceiver is further adapted to transmit signals directly to the portable device. See column 6, lines 44-47 where it is stated that "The device 10

may communicate various financial transaction data to and receive similar data from each of these terminal units”.

As per claim 5, Suer et al teach the signals implement local wireless communication. See column 9, lines 29-46.

As per claim 6, most ATM's are connected in a network for enabling the checking of funds in a bank associated with the user. See also column 16, lines 25-37.

As per claim 7, see the above analysis, and column 16, lines 25-37 and column 10, lines 42-63 of Suer et al.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Frantzy Poinvil
Primary Examiner
Art Unit 3692

FP
July 17, 2007